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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,025	03/18/2004	Ying-Chang Chen	BHT-3249-10	5614

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TROXELL LAW OFFICE PLLC  
SUITE 1404  
5205 LEESBURG PIKE  
FALLS CHURCH, VA 22041

EXAMINER
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HAMILTON, ISAAC N

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/803,025

Applicant(s)

CHEN, YING-CHANG

Examiner

Isaac N. Hamilton

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Invention I, claims 1-14 and 21, in the reply filed on 09/20/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

2. The disclosure is objected to because of the following informalities: the description for figures 1 and 2 should include an indication that they are prior art with language such as --(prior art)--; page 3, last paragraph, line 4, "the guiding posts 26" should be changed to --The guiding posts 32--; page 4, line 12, "with" should be changed to --without--.

Appropriate correction is required.

### ***Drawings***

3. Figure 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 3724

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “piston” in claim 5, line 2, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

4. Claims 1 and 10 are objected to because of the following informalities: claim 1, lines 4-5, “positioning” should be changed to --contacting-- because as shown in figures 5-7, the lens is not moving; claim 10, line 2, “plates respectively” should be changed to --plates move respectively--. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

Art Unit: 3724

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-14 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. On page 4, lines 10-20, the movement of the upper cutter and the lower 24 is recited. It is described that the cylinder 4 actuates the upper and lower plates 21, 22, respectively, to move toward and away from one another. However, figure 4 shows that plates 21 and 22 are fixedly connected via the cylinder 4. In figure 4, cylinder 4 is fixedly connected to plate 21 via threads, and cylinder 4 is connected to cylinder 4 via a rod that has threads on both ends. How do the plates move toward and away from each other if cylinder 4 is fixedly connected to both plates? Does cylinder 4 move relative to base 20? Does the element connecting plate 21 and cylinder 4 move relative to cylinder 4?

Additionally, claim 2 recites "the holding member defines a second direction different from the first direction," however, the holding member has guide posts 32 as shown in figure 3, which guide the post in the same direction as the first and second cutters. How does the holding member move in a second direction different from the first direction if the guiding posts of the cutting member and the guiding posts of the holding member are parallel?

***Claim Rejections - 35 USC § 102***

Art Unit: 3724

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohama et al (4,660,401), hereafter Kohama. Kohama discloses first direction in the vertical direction in figures 1, 2 and 14; first cutter 106; second cutter 126; the first cutter positions the workpiece in the first direction when elements 101, 106 and 108 are moved simultaneously into contact with workpiece 129; the second cutter cooperates with the first cutter to cut the workpiece as shown in figure 2; the apparatus in the figures is capable of cutting a plastic lens, and is capable of cutting an injection molded resilient product, wherein the resilient product is connected with at least one carrier to be removed therefrom; second direction is the horizontal direction as shown in figures 1, 2 and 14; holding member 131; the second direction is perpendicular to the first direction; first plate 114; second plate 123; cylinder 10; piston 17; base 128; guiding posts 17; power source is the press machine recited in column 15, line 45; the first time is when first cutter 106 contacts the workpiece; the second time is when the second cutter contacts the workpiece; the first time is earlier than the second time because first cutter must contact the workpiece simultaneously with element 108, which then forces element 115 to be depressed and allow the second cutter 126 to finally contact the workpiece.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kugler (2,526,955). Kugler discloses cutting member shown in figure 1; first cutter 6; second cutter 7; first direction is the vertical direction in figures 1-7; the first cutter is capable of positioning the

Art Unit: 3724

workpiece in the first direction by contacting the workpiece prior to the second cutter contacting the workpiece; the cutting member is capable of cutting a plastic lens and is capable of cutting an injection molded resilient product, wherein the resilient product is connected with at least one carrier to be removed therefrom; holding member 10, 11; second direction is the horizontal direction in figures 2, 4 and 5-7; first plate 4; second plate 5.

10. Claims 1 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Waltonen (Re. 33,798). Waltonen discloses cutting member in figure 1; first direction is the horizontal direction as shown in figure 2; first cutter 26; second cutter 22; first and second cutters are moved away and toward each other as shown in figure 2 by the phantom lines; the first cutter 26 contacts the workpiece 36 in the first direction as shown in figure 2; second cutter 22 cooperates with first cutter 26 to cut the workpiece; first plate 34; second plate 20; piston 24; cylinder 12; base 10; guiding posts in figure 5 juxtaposed elements 68 and 70; the first cutter is capable of contacting the workpiece before the second cutter when the workpiece is positioned closer to the first cutter initially; stopper 62; resilient component/spring 64 and 66; power source is recited in column 3, line 34; the apparatus is capable of cutting an injection molded resilient product; the workpiece 36 is inserted into the cutting device in a second direction perpendicular to the first direction as shown in figure 2.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3724

12. Claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waltonen in view of Sartorio (5,894,754). Waltonen discloses everything as noted above, but does not disclose a holding member, a movable holding plate, guiding posts, a holder, a recess, and does not disclose that the holder is exchangeable. Sartorio teaches holding member 64; movable holding plate 66; guiding posts 70, 72; exchangeable holder 98; and recess 104. It would have been obvious to provide a holding member, a movable holding plate, guiding posts, an exchangeable holder, and a recess in Waltonen as taught by Sartorio in order to position the workpiece at different positions. Note that holder 98 is exchangeable due to shank 106 and groove 114.

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Waltonen in view of Johnson (4,449,434). Waltonen discloses everything as noted above, but does not disclose heaters. Johnson teaches heaters in the abstract. It would have been obvious to provide heaters in Waltonen as taught by Johnson in order to reduce the amount of ware to the punch and die while cutting thermoplastic materials.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Watkins et al are cited for a first cutter and a second cutter moveable toward and away from each other.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.



Art Unit: 3724


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IH

November 27, 2006



KENNETH E. PETERSON  
PRIMARY EXAMINER